

Appl. No. : 09/251,218
Filed : February 16, 1999

REMARKS

With this amendment, Claims 17-37, 58-66 and 69 are canceled, and Claims 6 and 43 are amended to correct a typographical error. No new matter has been added. Claims 1-16, 38-57, 67 and 68 remain pending for further examination.

The specific changes to the amended claims are shown on a separate set of pages attached hereto and entitled VERSION WITH MARKINGS TO SHOW CHANGES MADE, which follows the signature page of this Amendment. On this set of pages, the insertions are underlined while the ~~deletions are stricken through~~.

Rejections Under 35 U.S.C. § 103

The Examiner has rejected pending Claims 1-16, 38-57, 67 and 68 under 35 U.S.C. § 103(a) as being unpatentable over Kenney (U.S. Patent No. 6,026,376) in view of Burke, Foley et al., Mills et al., and Gottschalk et al.

For Kenney, Burke, Foley, Mills, and Gottschalk to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the combination must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. See M.P.E.P. § 2142. In addition, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See M.P.E.P. § 2143.01.

Claim 1

The Examiner has rejected Claim 1 as being unpatentable over Kenney in view of Burke, Foley and Mills. The Examiner acknowledges that Kenney, Burke, and Foley "do not explicitly disclose said request comprising user-selected alterations of physical product exterior/interior options and said changed product presentation comprising said user selected alteration of physical exterior/interior options." However, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Mills and Gottschalk to the teaching of Kenney's virtual shopping to bring virtual

shopping to consumers that enables consumers to visually see the complete product with different configurations according to a consumer's choice. The Examiner further asserts that that since not many consumers would buy a car without visually seeing and/or test driving the final product including its options, it would have been obvious that when presenting the automobile online to consumers in order to influence their purchasing decision, consumers would want to be presented with the vehicle of their choices in complete components when doing comparison shopping online. Applicants respectfully disagree.

Claim 1 recites, *inter alia*, "said request comprising user-selected alterations of physical product exterior/interior options, said product display module configured to display the changed product presentation comprising said user-selected alterations of physical product exterior/interior options in said product display screen by modifying said definition of the product display screen." It is not clear how the Examiner relies on the combination of Kenney, Burke, Foley, Mills, Gottschalk to teach or suggest the claimed invention, as the prior art of record does not teach or suggest all the claim limitations of Claim 1.

Embodiments of the present invention, as recited in Claim 1 for example, include aspects that allow users to build and display their own custom, user-configurable products. Thus, the users are provided the capability to configure products with combinations of exterior and interior options that do not exist in a local dealer's inventory, or in any dealer's inventory for that matter.

For example, the users are provided the capability to view a product with an exterior configuration not in physical existence anywhere, or with an interior configuration not in physical existence anywhere. This aspect of user-selected alteration and viewing of options is highly advantageous and beneficial to the success of completing a sale in an online product configuration display system. None of the prior art references relied upon by the Examiner teach or suggest such features as are recited in Claim 1, nor do the cited references suggest the desirability of such combination.

The objective of the system in Kenney is to duplicate the physical shopping experience in an online environment. See, e.g., Abstract, Column 1, lines 27-34, and Column 1, lines 41-43. Conversely, embodiments of the present invention, for example as recited in Claim 1, enhance the shopping experience by providing capabilities that do not exist in the physical shopping

environment, such as configuring products with combinations of exterior and interior options that do not exist in a dealer's inventory.

The Examiner further asserts that "since not many consumers would buy a car without visually seeing and/or test driving the final product including its options, it would have been obvious that when presenting the automobile online to consumers in order to influence their purchasing decision, consumers would want to be presented with the vehicle of their choice in complete components when doing comparison shopping online." The mere assertion regarding consumers shopping propensities and preferences, whether accurate or not, does not establish the required showing of obviousness. In addition, currently many consumers must do just what the Examiner asserts they would not do, that is buy a car without seeing or test driving the final product including its options. Embodiments of the present invention, as in Claim 1, solve the problem that is noted by the Examiner.

Kenney describes a system for selecting static products off a virtual store shelf. Burke merely forecasts a prediction of the future viability of Internet shopping (as of 1997). Foley is an introductory text to three-dimensional computer graphics. Mills describes a computer-aided design (CAD) system for virtual manufacturing. Gottschalk reports that the Internet will change the way design engineers collaborate, study and communicate in the world. None of these references teach or suggest, or even contemplate, all the aspects of Claim 1, for example the aspect directed to user-selected alterations of physical product exterior/interior options in a product configuration display system. Furthermore, none of the cited references suggest the desirability of the combination, as § 2143.01 of the M.P.E.P. requires for an obviousness rejection to be proper.

All of the claim limitations of Claim 1 are not found in the combination of Kenney, Burke, Foley, Mills, and Gottschalk, nor is a teaching or suggestion to make the claimed combination found in these references. In addition, the prior art relied upon by the Examiner does not suggest the desirability of so combining the references, thus precluding a finding of obviousness under M.P.E.P. § 2143.01. Therefore, Applicants respectfully submit that Claim 1 recites patentable subject matter and thus is in condition for allowance.

Because Claims 2-16 depend from independent Claim 1, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claims to which they refer. It is

therefore submitted that these claims are in condition for allowance for at least for the reasons expressed with respect to the independent claim, and for their other features.

Claim 38

The arguments with respect to Claim 1 similarly apply to independent Claim 38. Furthermore, Claim 38 recites "comprising user-selected alterations of physical product exterior/interior options" in the "providing a data center," "receiving a request" and "modifying said definition" steps. As the Examiner has not provided any support or explanation in rejecting these aspects of Claim 38, Applicants are unsure as to the basis for the Examiner's rejections. The M.P.E.P. states that "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." See M.P.E.P. § 706.02(j). Applicants respectfully submit that the Examiner has failed to properly communicate the basis for the rejection of Claim 38, thus denying Applicants of a fair opportunity to reply.

However, even assuming that the rejections of Claim 38 are for reasons similar to those given in the Examiner's rejection of Claim 1, the arguments presented above with respect to Claim 1 apply with equal force to Claim 38. Therefore, Applicants respectfully submit that Claim 38 recites patentable subject matter and thus is in condition for allowance.

Because Claims 39-57 depend from independent Claim 38, pursuant to 35 U.S.C. § 112, ¶ 4, they incorporate by reference all the limitations of the claims to which they refer. It is therefore submitted that these claims are in condition for allowance for at least for the reasons expressed with respect to the independent claim, and for their other features.

Claim 67

In rejecting Claim 67, the Examiner merely repeated verbatim the previous rejection of Claim 1 and included reference to Claim 67 by number only in the rejection of Claim 1. However, Claim 67 includes several aspects not recited in Claim 1. For example, Claim 67 includes a second product and recites "wherein said first and second modified product presentations are stored as first and second stored product presentations, and wherein said product display module is configured to retrieve and simultaneously display said first and second

stored product presentations comprising said user-selected alterations of physical product exterior/interior options... ." Referring again to M.P.E.P. § 706.02(j), Applicants respectfully submit that the Examiner has failed to properly communicate the basis for the rejection of Claim 67, thus denying Applicants of a fair opportunity to reply. Applicants respectfully submit that Claim 67 is in condition for allowance as discussed above with regard to Claim 1.

Because Claim 68 depends from Claim 67, pursuant to 35 U.S.C. § 112, ¶ 4, it incorporates by reference all the limitations of the claim to which it refers. It is therefore submitted that Claim 68 is in condition for allowance for at least for the reasons expressed with respect to independent Claim 67, and for its other features.

Response to Examiner's Remarks

In the Response to Arguments section (pages 24-25) of the Office Action dated August 21, 2002, the Examiner asserts that "since not many consumers would buy a car without visually seeing and/or test driving the final product including its options, it would have been obvious that when presenting the automobile online to consumers in order to influence their purchasing decision, consumers would want to be presented with the vehicle of their choice in complete components when doing comparison shopping online." As discussed above with regard to Claim 1, the mere assertion regarding consumers shopping propensities and preferences, whether accurate or not, does not establish the required showing of obviousness. In addition, currently many consumers must do just what the Examiner asserts they would not do, that is buy a car without seeing or test driving the final product including its options. Embodiments of the present invention, as recited in the pending claims, solve the problem that is noted by the Examiner. Accordingly, Applicants respectfully submit that the Examiner has not met the burden of establishing a *prima facie* case of obviousness as required by the M.P.E.P. and enumerated above.

The Examiner also asserts in the Response to Arguments section that "[i]t would also have been obvious that the consumer would want to be presented with the vehicle of their choice in complete components when doing comparison shopping online such as making an online decision of buying a car by comparing for instance a BMW versus a Mercedes or WWW.bmw.com and WWW.mercedes.com. Both web sites are capable of providing display

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products exteriorly and interiorly." Applicants respectfully submit that the Examiner has not met the burden of establishing a *prima facie* case of obviousness with regard to this assertion as discussed above in the preceding paragraph. Furthermore, Applicants note that the filing date of the present application is February 16, 1999. The Examiner has provided no documentation that the websites listed (www.bmw.com and www.mercedes.com) provided the asserted capability prior to Applicants' priority date of February 16, 1999, nor has the Examiner cited either of these websites as prior art references. Therefore, Applicants respectfully submit that these websites do not constitute prior art to the present application.

CONCLUSION

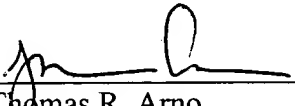
Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, arguments in support of the patentability of the pending claim set are presented above. In light of these remarks, reconsideration and withdrawal of the outstanding rejections is respectfully requested.

If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 12/20/02

By: 
Thomas R. Arno
Registration No. 40,490
Attorney of Record
620 Newport Center Drive
Sixteenth Floor
Newport Beach, CA 92660
(619) 235-8550

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 6 and 43 have been amended as set forth below:

6. (AMENDED) The system as defined in Claim 5, wherein said first axis is a substantially horizontal axis and said second axis is a substantially vertical axis.

43. (AMENDED) The method as defined in Claim 42, wherein said first axis is a substantially horizontal axis and said second axis is a substantially vertical axis.

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